

Amendment
Serial No. 10/698,934
Attorney Docket No. 032044

REMARKS

Claims 1-4 and 6-10 are pending in the present application and are rejected. Claims 1-4 and 6-10 are herein amended.

Preliminary Comment

This Amendment is supplemental to the Amendment filed on April 17, 2006. The Supplemental Amendment is identical except that a marked-up copy of the substitute specification as well as a clean copy of the substitute specification is included.

Applicants' Response to Objections to the Specification

The Office Action notes that the specification is not in proper idiomatic English and requires a substitute specification. In response, Applicants herewith submit a substitute specification, which incorporates the appropriate corrections. No new matter has been added.

The Office Action notes that the title is not descriptive. In response, Applicants herein amend the title as follows:

~~A BIODEGRADABLE PLASTIC AN ALIPHATIC POLYESTER~~
COMPOSITION, A MOLDED ARTICLE THEREOF AND A METHOD FOR
CONTROLLING BIODEGRADATION RATE USING THE SAME
COMPOSITION

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Applicants Response to Claim Rejections under 35 U.S.C. §112

Claims 1-10 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

It is the position of the Office Action that the specification is enabling for “aliphatic copolymers,” but does not provide enablement for biodegradable plastic generally. Specifically, the Office Action notes that there is no support with regard to biodegradable plastics including polysaccharides, such as cellulose, starch, or polyvinyl alcohols.

In response, Applicants herein amend the claims in order to specify an “aliphatic polyester.” Accordingly, Applicants cancel claim 5, which recites that the biodegradable plastic is an aliphatic polyester.

Claim 10 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

It is the position of the Office Action that the metes and bounds of the phrase “in such a way” cannot be determined, and thus it is vague and confusing. In response, Applicants herein amend claim 10 in order to remove this phrase.

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Double Patenting

Claims 1-10 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of co-pending Application No. 11/051,462 in view of Kaufhold et al. '266 (U.S. Patent No. 6,559,266), Kaufhold et al. '995 (U.S. Patent No. 6,527,995) or Prissok et al. (U.S. Patent No. 5,900,439).

Claims 1-10 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of co-pending Application No. 11/172,904 in view of Kaufhold et al. '266 (U.S. Patent No. 6,559,266), Kaufhold et al. '995 (U.S. Patent No. 6,527,995) or Prissok et al. (U.S. Patent No. 5,900,439).

It is the position of the Office Action that each of the '462 application and the '904 application discloses the manufacture of a biodegradable plastic using a carbodiimide and optionally including an ultraviolet absorber. The Office Action relies on Kaufhold '266, Kaufhold '995, or Prissok to disclose the use of a benzotriazole as an ultraviolet absorber.

Applicants note that these rejections are “provisional” at this time. Therefore, Applicants defer action in response to this rejection until a later date.

Applicants' Response to Claim Rejections under 35 U.S.C. §102

Claims 1-10 were rejected under 35 U.S.C. §102(b) as being anticipated by Kage et al. (U.S. Patent No. 5,714,220)

It is the position of the Office Action that Kage discloses the invention as claimed. Kage discloses a container composed of a saturated polyester resin composition. As disclosed at

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column 2, lines 27 to 43, this container may include include a saturated polyester [A], a benzotriazole weathering stabilizer [D], and a carbodiimide compound [F].

Specifically, Applicants note that Kage discloses a saturated polyester consisting essentially of ethylene terephthalate. Kage clearly explains the structure of the saturated polyester at column 2, lines 42-63:

The saturated polyester used in the invention is derived from a dicarboxylic acid containing a terephthalic acid and a diol containing ethylene glycol.

This saturated polyester is obtained by polycondensing a dicarboxylic acid containing a terephthalic acid or its ester derivative (e.g., lower alkyl ester of terephthalic acid, phenyl ester of terephthalic acid) and a diol containing ethylene glycol or its ester derivative (e.g., ethylene oxide monocarboxylic ester).

The saturated polyester used in the invention may be either homopolyethylene terephthalate derived from the above-mentioned terephthalic acid and ethylene glycol or a copolymerized polyester obtained by using, as a dicarboxylic acid, other dicarboxylic acid than the terephthalic acid in addition to the terephthalic acid and using, as a diol, other diol compound than ethylene glycol in addition to ethylene glycol. If the saturated polyester is such a copolymerized polyester as mentioned above, this polyester may contain constituent units derived from the dicarboxylic acid other than the terephthalic acid and the diol other than ethylene glycol in amounts of not more than 20% by mol.

This description shows that 80% by mol or more of the saturated polyester used is composed of ethylene terephthalate. As a result, the saturated polyester in Kage is an ester of terephthalic acid, an aromatic carboxylic acid.

As noted above, Applicants herein amend the claims in order to recite an aliphatic polyester. Applicants respectfully submit that this amendment also obviates the rejection based on Kage, since Kage does not disclose or suggest the use of an aliphatic polyester combined with a carbodiimide compound and at least one compound selected from the group consisting of

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benzotriazole-, triazine- and hydroxylamine-based compounds. **Kage** only discloses the use of an aromatic polyester, and does not disclose or suggest the use of an aliphatic polyestester. Favorable reconsideration is respectfully requested.

Claims 1-4, 6, and 8-10 were rejected under 35 U.S.C. §102(b) as being anticipated by Kobayashi et al. (U.S. Patent No. 4,500,686)

It is the position of the Office Action that **Kobayashi** discloses the invention as claimed. **Kobayashi** discloses a polyester type block copolymer composition containing a benzotriazole. However, it is noted that **Kobayashi** also only discloses aromatic polyesters, and does not discuss aliphatic polyesters.

As noted above, Applicants herein amend the claims in order to recite an aliphatic polyester composition in order to overcome the rejection based on 35 U.S.C. §112, first paragraph. Applicants respectfully submit that this amendment also obviates the rejection based on **Kobayashi**, since **Kobayashi** does not discuss aliphatic polyesters. Favorable reconsideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

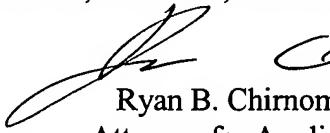
Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned agent.

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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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Enclosure: Substitute Specification (clean and marked-up copies)